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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/058,662 | 01/28/2002 | Ryoichi Mukai | 2500.66134 | 3822 |

7590 08/19/2004

Patrick G. Burns, Esq.
GREER, BURNS & CRAIN, LTD.
Suite 2500
300 South Wacker Dr.
Chicago, IL 60606

EXAMINER

PIZIALI, ANDREW T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1771

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|--------------------------------------|---------------------------------------|--|
| Advisory Action | Application No. 10/058,662 | Applicant(s) MUKAI, RYOICHI | |
| | Examiner Andrew T Piziali | Art Unit 1771 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: .

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive.

The applicant asserts that Chen fails to teach or suggest spatially spaced metallic nucleation sites. The applicant asserts that Figure 2 illustrates grains (74) that are not spatially spaced. The examiner agrees that some of the grains in Figure 2 of Chen are not spatially spaced, but that other grains are spatially spaced. For example, numbering the grains from left to right, the first and second grains are not spatially spaced, but the first and third grains are spatially spaced. Specifically, the second grain is occupying the space separating the first and third grains. Considering the use of open claim language (comprising), Chen clearly reads on the current claims.

The applicant asserts that an alloy is not a compound. The applicant asserts that the examiner has given "compound" a meaning inconsistent with the current specification. The examiner respectfully disagrees. Firstly, the applicant has failed to point to a specific portion of the specification that teaches or suggests that an alloy would not be considered a compound. Secondly, the specification states "The compounds may be metallic compounds, for example" (page 2, 19-22). Therefore, although the specification gives examples of compounds such as metallic oxides or metallic nitrides (page 2, lines 19-22), the specification clearly does not limit the compounds to these examples. Finally, the applicant states that the definition, "a pure chemical substance consisting of two or more different elements in definite proportions that cannot be separated by physical means" is "entirely consistent with applicant's definition." The examiner contends that an alloy is a compound even based on this definition.

g-r 8/12/04
ANDREW T. PIZALI
PATENT EXAMINER

Terrel Morris
TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700